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EXAMINER

COLE, ELIZABETH M

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/783,107
Filing Date: February 20, 2004
Appellant(s): SHIMODAIRA ET AL.

George A. Smith, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/22/06 appealing from the Office action mailed 4/10/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The grounds of rejection listed immediately below are hereby withdrawn.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claims 1-2, 5-8

based on Eklund in view of WO '558 and of claims 3-4 over Eklund in view of WO '558 and further in view of Gulya are withdrawn in view of Appellant's arguments set forth in the Appeal Brief.

NEW GROUNDS OF REJECTION

Claims 3-4 rejected under 35 U.S.C. 102(e) as anticipated by Watanabe, U.S. Patent Application Publication 2003/0051848

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0051848	Watanabe	3-2003
WO 03/029558	Beck	4-2003
6,159,880	Schiel	12-2000
4,446,187	Eklund	5-1984
5,071,697	Gulya	12-1991

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1,2, 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press felt as set forth in the preceding paragraph. Watanabe discloses a press having excellent rewetting suppression comprising a base layer, batt layers and a rewetting

prevention layer. The layers are bonded by needling. See paragraph 0028. The rewetting prevention layer comprises a thin film. See paragraph 003. The film is perforated by needling punching. The perforation process produces holes having a three dimensional structure wherein the perforations have a funnel shape. See paragraphs 0034, 0045, 0048, and 0053, as well as figure 3. the layer can also have planar openings in addition to the three-dimensional openings. See claim 2. Watanabe teaches the use of nylon films as the rewetting prevention layer. See paragraph 0035. With regard to the limitation that the rewetting prevention layer is non-oriented, it is noted that while Watanabe teaches that biaxially oriented films are "suitable" for use, Watanabe also generically teaches the use of films as the rewetting prevention layer. Further, Watanabe teaches that using a biaxially oriented film prevents splitting of the of the film during the needling process, and therefore Watanabe implicitly teaches that using unoriented films is less preferred, but known. See paragraph 0049. Finally, it is noted that Watanabe's claims are not limited to an oriented film. The final rejection inadvertently omitted claim 2 from the statement of the rejection. However, the limitations of claim 2, (the funnel-shaped opening and tubular portion) were clearly addressed in the rejection and therefore it is believed that Applicant understood which claims were being rejected. The error is regretted.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel, U.S. Patent No. 6,159,880 in view of WO '558. Schiel discloses a pres felt comprising a batt layer 2, a support layer comprising warp and weft threads 3 and 4 and an intermediate layer 12 which may be a film layer. See figures 1 and 4. Schiel does

not disclose that the film is oriented and therefore it is reasonable to presume that it is unoriented. The layers can be needled together. The needling would necessarily perforate the film and the perforations would necessarily have the claimed shape since they are formed in the same way as the perforations in the instant application. While Schiel appears to disclose the claimed structure, Schiel does not explicitly state that the intermediate layer is an anti-rewetting layer. WO '558 teaches incorporating an anti-rewetting layer within the press felt in order to prevent re wetting. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed an anti rewetting layer as the intermediate layer in Schiel, motivated by the expectation that this would prevent rewetting when the press felt of Schiel was used.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel in view of WO '558 as applied to claims above, and further in view of Gulya et al, U.S. patent No. 5,071,697. WO '553 differs from the claimed invention because WO'553 does not teach employing a nylon layer as the rewetting prevention layer. Gulya teaches at col. 2 lines 56-61, that nylon films are suitable for use as the rewetting prevention layer in a press felt. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed a nylon layer as the rewetting prevention layer of WO '553, motivated by the teaching of Gulya that this type of film was known in the art to be suitable for this purpose. With regard to the claimed elongation at break, either the nylon layer of Gulya would inherently

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possess the claimed elongation at break, or else it would have been obvious to have selected the film composition, thickness, etc., so that it had the desired strength.

Claims 13-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Schiel in view of WO '558 as applied to claims above, and further in view of Eklund. Neither Schiel nor WO '558 teach including both flat apertures and protuberances on the rewetting prevention layer. Eklund teaches that the openings can have any configuration. See col. 3, lines 39-56. Therefore, it would have been obvious to one of ordinary skill in the art to have selected the shape and depth of the openings through the process of routine experimentation as taught by Eklund in order to form a press felt having the optimum rewetting prevention characteristics.

NEW GROUNDS OF REJECTION

Claims 3-4 rejected under 35 U.S.C. 102(e) as anticipated by Watanabe, U.S. Patent Application Publication 2003/0051848. Watanabe discloses a press felt as set forth above. Watanabe does not disclose the claimed elongation at break, however, since Watanabe discloses the same structure and the same materials, presumably the film of Watanabe would inherently have the claimed elongation at break. It is noted that the final rejection employed the incorrect claim numbers, (2-3 instead of 3-4), for this grounds of rejection. The error is regretted. Since the rejection clearly refers to the limitations found in claims 3 and 4 it is believed that Applicant understood which claims were being rejected.

(10) Response to Argument

With regard the Watanabe reference, Appellant argues that Watanabe does not disclose an unoriented film. However, Watanabe discloses that biaxially oriented films are suitable for use and that the use of biaxially oriented films prevent splitting during the needling process. Therefore, unoriented films are implicitly disclosed in Watanabe as are uniaxially films, although they are not preferred. However, since the Watanabe reference is a 102 reference the disclosure of a non preferred embodiment still anticipates the claimed invention. Also, since the claims of Watanabe do not specify that the films are biaxially oriented, or oriented at all, it is the examiner's position that Watanabe discloses films generally and that biaxially oriented films are the preferred embodiment, but that the claims of Watanabe also encompass and disclose unoriented films and uniaxially oriented films.

Appellant argues that there is no express disclosure of an unoriented film in Watanabe, nor is such a film inherently described. However, with regard to a film, there are only three possibilities: unoriented, uniaxially oriented or biaxially oriented. Watanabe discloses and claims "films" generally, without qualification. Watanabe further teaches that biaxially oriented films are suitable or preferred. The teaching that such biaxially oriented films are preferred, rather than that such film are required, clearly shows that the disclosure of Watanabe encompasses films other than biaxially oriented films. Since there are only three types of films which are possible, uniaxially oriented, biaxially oriented or unoriented, the person of ordinary skill in this art would immediately

know that the disclosure of "films" generally in Watanabe would encompass all three types of films. Therefore, Watanabe does disclose a unoriented film.

Appellant argues that none of the examples employ a non-oriented film. However, the teachings of a reference are not limited to what is shown in the examples. Watanabe clearly teaches films generically and also claims such films. Since only three types of films are possible, uniaxially oriented, biaxially oriented and unoriented, the generic disclosure of films, would cause the person of ordinary skill in the art to know that all three types of films could be used, even if biaxially oriented films were preferred.

With regard to claims 2 and 3, Appellant argues that the rejection of these claims should be reversed for the same reasons as were advanced against claim 1. Therefore, the same responses to these arguments apply to claims 2 and 3.

With regard to claim 3, Appellant further argues that Watanabe does not disclose the same material since Watanabe does not disclose an unoriented film and therefore it cannot be said that the film would inherently possess the claimed elongation at break. However, as set forth above, since Watanabe does teach films generally, the person of ordinary skill in this art would know that films can be either uniaxially oriented, biaxially oriented or unoriented and therefore Watanabe does teach unoriented films.

Appellant's arguments regarding Eklund are persuasive and this grounds of rejection is withdrawn as set forth above.

With regard to the rejection based on Schiel in view of WO '558, Appellant argues that the rejection misinterprets Schiel because Schiel does not teach the claimed openings shape and does not teach a film layer. However, with regard the

claimed shape of the openings, Schiel teaches forming the openings by needling. The instant specification also teaches forming the openings by needling, and therefore, since needling produces the claimed shape as taught by the specification, it is reasonable to presume that the openings of Schiel, which are formed the same way, would have the claimed shape.

With regard to the argument that Schiel does not teach a film layer, Appellant points to the fact that Schiel employs the term “foil” rather than film. However, initially, it is noted that the term “foil” is often used interchangeably with the term “film” in this art. For example, the Eklund reference uses the term “foil” to mean “film” throughout the reference. Further, with specific regard to the Schiel reference, although Schiel does call the layer a batt at one point, the drawings clearly show that layer 12 is not a batt. Further, Schiel clearly teaches that the layer 12 is an intermediary layer which can be made of fibers or of foil at col. 6, lines 25-27. Appellant argues that this means that the foil can somehow be transformed into fibers by cutting or shredding and then used to make the batt, however, there is nothing in Schiel to support this interpretation. Further, if the foil were transformed into strands or fibers, then there would be no reason to make a distinction between a layer made from fibers and a layer made from foil, since both layers would be fibrous and have the same or very similar structure. Further, col. 3, lines 9-12, clearly teaches a foil layer as an intermediate layer, when it refers to an originally watertight foil which is rendered pervious by needling. Therefore, Schiel does teach an intermediate film layer and does teach needling the film layer. Since the instant specification teaches that it is the needling process which forms the particular

shape of the openings, and since Schiel clearly teaches needling the film layer, the material of Schiel would necessarily have openings having the claimed shape.

With regard to dependent claims 11-12, Appellant argues that these claims are patentable for the reasons advanced with regard to independent claim 9. Therefore, the same responses to the arguments which are set forth above also apply to these claims.

With regard to claims 13-16, Appellant argues that Eklund does not teach both flat apertures and protuberances. However, Eklund does teach that the openings can have any configuration and can have shapes that differ from one another. Eklund teaches that the openings can have different shapes and that the walls can also have different shapes, and that such shapes can be chosen and controlled in order to optimize the permeability of the finished material. See col. 6, lines 8-64. Therefore, the person of ordinary skill in the art would have been able to select the size and shapes of the openings through the process of routine experimentation in order to arrive a material having the desired permeability.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Elizabeth M. Cole/

Primary Examiner, Art Unit 1794

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Jennifer Michener/

Jennifer Michener

Quality Assurance Specialist, TC1700; Director Designee

Conferees:

/Terrel Morris/

Terrel Morris, SPE 1794

/Jennifer Michener/

Quality Assurance Specialist, TC1700